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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,454	01/02/2002	Ulrich Watermann	12383-04/ejg	6577
33797	7590	10/09/2003	EXAMINER	
MILLER THOMPSON, LLP 20 QUEEN STREET WEST, SUITE 2500 TORONTO, ON M5H 3S1 CANADA			GELLNER, JEFFREY L	
			ART UNIT	PAPER NUMBER
			3643	

DATE MAILED: 10/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/032,454

Applicant(s)

WATERMANN, ULRICH

Examiner

Jeffrey L. Gellner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 5-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 5-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17-2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC §103

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims are rejected under 35 U.S.C. §103(a) as being unpatentable over Takeda (JP2000-354447) in view of Chase (US 1,428,216).

As to Claim 1, Takeda discloses a device for scaring birds comprising a silhouette (1 of Fig. 5) of a cat having at least two holes (4s of Fig. 5) therethrough, a first line (6 of Fig. 5) having one end rotatably attached to one of the holes and a second line (other 6 of Fig. 5) having one end rotatably attached to the other hole; A third line (10B of Fig. 5) having one end rotatably attached to one of the holes (see Fig. 5 in that the line is attached to the hole through element 6) and to one end of the first line (see Fig. 5); and, another end rotatably attached to the other hole (see Fig. 5 in that the line is attached to the hole through element 6) and to the end of the second line (see Fig. 5) for rotation of the third line relative to the first and second lines (Examiner considers the third line to be capable of rotating independent of the other two lines) so as to maintain continuity between one end of the first and second lines, respectively, when the first and second lines become unattached to from the holes. Though Takeda does not show the third line being connected to the previously mentioned "end" of the lines, it has been held that rearranging parts of an invention involves only routine skill in the art. Takeda fails to teach a

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silhouette of a bird of prey as a means of scaring off other birds. However, Chase teaches the use of a silhouette (5 of Fig. 1) of a bird of prey as a scarecrow. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the scaring device disclosed by Takeda to include a silhouette of a bird of prey, as shown by Chase, in an effort to provide a means of scaring off various species of birds.

Regarding Claim 2, Takeda as modified by Chase, teaches a device further including a swivel (5C) connected to the holes (4). One end of the first and second lines (6) is connected to the swivel (5C) so as to permit the silhouette (1) to rotate relative to the lines (6). Takeda fails to show the ends of the third line directly connected to the swivels. However, it would have been obvious to one having ordinary skill in the art to relocate the third line (1013) since it has been held that rearranging parts of an invention involves only routine skill in the art. See Figure 1 above.

In regards to claim 5, Takeda as modified by Chase in claim 1, further teaches a device wherein the third line (10B - See Takeda -Figure 5) extends across the silhouette.

Regarding claim 6, Takeda as modified by Chase further discloses a silhouette (1) comprising a light reflecting film (3). Vinyl can be considered a light reflecting material. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to construct the silhouette out of vinyl panel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

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Regarding claim 7, Takeda, as modified by Chase, further teaches a device wherein the first line (6) has another end adapted to be secured to an object above the ground and the second line (6) has another end adapted to be secured to the ground (See Takeda - Figure 4).

In regards to claim 8, Takeda as modified by Chase further teaches a device wherein the panel freely rotates about the first and second lines (6). See Figure 1 above.

Regarding claim 9, Takeda as modified by Chase further discloses a device wherein the panel is colored and shiny and reflects light as the panel freely rotates about the line (6). See Takeda abstract.

In regards to claim 10, Takeda as modified by Chase, does not specifically disclose a device adapted to be attached to the top of the building. However, it would have been an obvious matter of design choice to increase the length of the lines (6) in order to reach to the top of the building, since such a modification would have involved a mere change in size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art.

Claims 11-12 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Takeda (JP2000-354447) in view of Chase (US 1,428,216) further in view of Kaleta (US 5,322,032).

In regards to claim 11, Takeda as modified by Chase, fails to teach grommets for reinforcing the holes (4) of the silhouette (1). However, Kaleta, shows a hanging device including grommets around the holes. See Kaleta - Figure 1. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to further modify the device by Takeda, as modified by Chase, to include grommets around the holes, as shown by

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Kaleta, in order to provide reinforcement so that the line does not rip through the holes in the vinyl panel.

Regarding claim 12, Takeda, as modified in the previous claim, teaches a device including a first swivel (5) connected to the first grommet where the first line (6) has one end connected to the first swivel (5). A second swivel (5) is connected to the second grommet where the second line (6) has an end connected to the second swivel (5). Takeda, as modified, fails to show a third line connected to the first and second swivels. The third line (10B) disclosed by Takeda is connected to the lines (6) above and below the swivels. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to relocate the third line, since it has been held that rearranging part of an invention involves only routine skill in the art.

In regards to claim 13, Takeda as modified by Chase, Kilgore and Kaleta, as explained in the arguments for claims 1-12 above, discloses a device comprising a vinyl sheet profiling a bird of prey having first and second holes (4) therethrough. A first and second grommet for reinforcing the first and second holes (4) is included, as well as a first swivel (5) connected to the first grommet and a second swivel (5) connected to the second grommet. The first and second swivels include hole attaching means (8) and rotatable means (5). The device also has a first line (6) having an end connected to the first rotatable means (5) for rotatable movement about the first attaching means (8) and a second line (6) having an end connected to the second rotatable means (5) for rotatable movement about the second attaching means (8). A safety line (1013) has one end connected to the first hole attaching means (8) and another end connected to the second

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hole attaching means (8) (see argument above for rearrangement of parts) where the safety means can rotate relative to the first and second lines. This device inherently performs the method steps recited in Claim 13.

In regards to claim 14, Takeda as modified above, teaches a device with the second line attached to the ground (See Takeda - Figure 4) but does not specifically disclose a device adapted to be attached to the top of the building. However, it would have been an obvious matter of design choice to increase the length of the first line (6) in order to reach to the top of the building, since such a modification would have involved a mere change in size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art.

Regarding claim 15, Takeda as modified in the previous claims, discloses a silhouette comprising a light reflecting film (3) that rotates about the first and second lines (6) so as to scare birds. Black, shiny vinyl can be considered a light reflecting material. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to construct the silhouette out of vinyl panel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

In regards to claims 16 and 17, Takeda as modified above, teaches a bird scaring device that can be adapted to attach to a kite or in between two upright posts. It is an obvious matter of design choice to vary the lengths of the lines (6) in order to attach the device to various

structures, since such a modification would have involved a mere change in size of a component.

A change in size is generally recognized as being within the level of ordinary skill in the art.

In regards to claim 18, Takeda as modified by Chase, Kilgore and Kaleta in the arguments above, discloses a method of scaring birds that comprises the steps of securing the silhouette (1) of a bird of prey in position by connecting a first swivel (5) having a first clip (8) and a first rotatable means (5) by connecting the first clip (8) to a first hole (4) in the silhouette. Then the first end of the first line (6) is connected to the first rotatable means (5). A second swivel (5) having a second clip (8) and a second rotatable means (5) is connected to a second hole (4) in the silhouette (1) and the first end of the second line (6) is connected to the second rotatable means (5). Then the silhouette (1) is reinforced by connecting one end of a safety line (1OB) across the silhouette (1) to the first clip (8) and the other end of the safety line (1OB) to the second clip (9). The silhouette (1) is then moved by the wind to so as to scare birds.

In regards to claim 19, Takeda as modified above, teaches a method of scaring birds wherein the second line is attached to the ground (See Takeda - Figure 4) but does not specifically disclose a the first line adapted to be attached to the top of the building. However, it would have been an obvious matter of design choice to increase the length of the first line (6) in order to reach to the top of the building, since such a modification would have involved a mere change in size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art.

In regards to claim 20, Takeda as modified above, teaches a method of scaring birds wherein the device can be adapted to attach to a kite and another object so as to scare birds away from a field. It is an obvious matter of design choice to vary the lengths of the lines (6) in order to attach the silhouette to various structures, since such a modification would have involved a

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mere change in size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art.

Regarding claim 21, Takeda as modified above, teaches a method as claimed in claim 18 including the step of maintaining the continuity between the first end of the first line (6) and the first end of the second line (6) when the first and second clips (5) become disconnected from the holes (4).

In regards to claim 22, Takeda as modified above, teaches the method wherein the safety line (10B) is connected to lie substantially in the same plane as the silhouette (1).

As to Claim 23, the lines being nylon is not disclosed. Examiner takes official notice that it is old and notorious well known in the attachment art to make lines of nylon. It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the method of Takeda as modified by Chase, Kilgore and Kaleta by making the lines of nylon depending upon ease of manufacture and availability of material.

As to Claim 24, Takeda as modified by Chase, Kilgore and Kaleta further disclose the third line extending between the holes (in that in Fig. 5 the lines goes between the two holes and beyond).

Allowable Subject Matter

If the independent Claims were amended to disclose that the third, or safety, line directly connected to the first and second swivels the Examiner would allow the application to pass to issue.

Response to Arguments

Applicant's arguments filed 24 July 2003 have been fully considered but they are not persuasive. The crux of Applicant's arguments are (1) neither Takeda or Chase discloses a third string attached to one and to the other hole (Remarks at page 9); and, (2) Takeda's element 10 may not be a line or material comprised of nylon (Remarks at page 10 last para.).

As to argument (1), Examiner considers element 10 of Takeda to be attached to the holes though other elements. Element 10 is not directly attached to the holes or swivels.

As to argument (2) the term line can defined as "a tread, string, cord, rope . . . " (Merriam-Webster's Collegiate Dictionary at page 677). Cord is defined as "a long slender flexible material usually consisting of several strands . . ." (Merriam-Webster's Collegiate Dictionary at page 257). Here, Examiner considers element 10 of Takeda to be a long slender flexible material.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. EP 0127404 discloses in the prior art a device for scaring birds with three lines.

Watermann is in the instant Application's pre-grant publication.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jeffrey L. Gellner whose phone number is 703.305.0053. The Examiner can normally be reached Monday through Thursday from 8:30 am to 4:00 pm. The Examiner can also be reached on alternate Fridays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Peter Poon, can be reached at 703.308.2574. The official fax telephone number for the Technology Center where this application or proceeding is assigned is 703.872.9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.1113.



Jeffrey L. Gellner



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